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Attorney Docket No.: 12730-11

Client Ref. No.: PA-5327-CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Osbourne <i>et al.</i>)	
Serial No.: 10/642,513)	Examiner: William H. Matthews
Filing Date: August 15, 2003)	Group Art Unit No.: 3774
For: Stent and Method of Forming a)	Confirmation No.: 3839
Stent with Integral Barbs)	

APPELLANTS' REPLY BRIEF

Mail Stop - Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is timely filed in response to the Examiner's Answer dated June 27, 2011.

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I. ARGUMENT

For at least the reasons set forth in Appellants' primary brief, its previous responses to office actions, the previous appeal, the Board's decision and here, the Examiner's rejection of the claims based on the combination of Anderson and Boatman is baseless and the Board should reverse the Examiner.

A. As A Matter Of Law Anderson Does Not Explicitly Or Inherently Disclose At Least One Unbent Barb

Not only does the Examiner admit (see page 5 of the Examiner's answer) that Anderson does not explicitly disclose unbent barbs, he also admits that Anderson discloses that the "barbs will bend outwardly when the stent is expanded."¹ (Page 7, quoting Anderson column 9, lines 16-26). Yet, the Examiner continues to argue that Anderson suggests unbent barbs. This argument essentially dismisses the fact that the Board has already rejected the Examiner on this contention, and that the Board held that it is equally probable (and therefore neither explicit nor inherent) that Anderson's barbs are bent. Inherency may not be established by probabilities, or even possibilities, as a matter of law, and, therefore, Anderson does not disclose "at least one barb is unbent with respect to the wire and is free of weakening due to bending," as recited by the claims.

The Examiner's Answer on this issue merely rehashes old arguments already rejected by the Board and the Board should reject them again.

B. The Examiner Ignores That Inherency Is Part Of The Obviousness Query

The Examiner appears to take issue with the Board's previous decision finding on the issue that "the barbs 20 of Anderson are not necessarily unbent with respect to the wire," apparently because the Examiner's previous rejection was based on *anticipation* and now the Examiner relies on obviousness. (Examiner's

¹ The Examiner's argument that the particular step etching process described that can be used so that the barbs bend outwardly when the stent is expanded is "not necessarily required" does not negate the Board's finding of no inherent disclosure and, indeed, supports it.

Answer, p. 6). This distinction is irrelevant. As this Board has recently and repeatedly held, inherency is part of the obviousness query. See, *Ex Parte Kobi Vortman and Shuki Vitek*, 2011 WL 362736, *3 (Bd.Pat.App. & Interf.) (reversing the Examiner's finding of obviousness because the Examiner failed to show to any degree that the missing claim element was expressly or inherently present in the primary reference.) Hence, the Board's opinion fully applies here. If anything, the fact that Anderson does not expressly disclose "at least one barb is unbent with respect to the wire and is free of weakening due to bending" demonstrates the nonobviousness of this feature. To be sure, the Examiner has not identified any evidence that a person of ordinary skill would have recognized an inherent disclosure in Anderson of the missing claim limitations. See, *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) ("That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.") (citing *In re Spormann*, 363 F.2d 444, 448 (CCPA 1966)).

The Examiner contends that Appellants ignore the Board's statement that "both situations [referring to whether Anderson does or does not disclose that the barbs are unbent] are equally probably [sic]," but this is wrong. Indeed, this statement by the Board is a primary reason why the present rejection is improper. The fact that both situations are "equally probable" means that it is just as likely that the barbs are bent as they are unbent and, hence, that there is no explicit or inherent disclosure of this claim limitation. This case illustrates the hazards of relying on inherency in obviousness rejections. See, *Ex Parte Nobuyuki Nagayama, Hiroyuki Nakayama, and Kouji*, 2011 WL 3627361, *3 (Bd.Pat.App. & Interf.), relying on *In re Rijckaert*, 9 F.3d at 1534. For at least this reason, the Board's previous opinion is equally applicable here and the Board should again reverse the Examiner on this basis.

C. The Examiner Misinterprets The Anderson Disclosure

The Examiner misinterprets the Anderson disclosure in key aspects. First, the Examiner acknowledges that, "while literally stating the 'removing portions of

material so that the barbs will bend outwardly', [Anderson] does not explicitly require removing material of the barbs." The Examiner then posits that the disclosure of removing material from the area of the barbs can also mean "removing material from the arches with the barbs thereon" because it "is still an 'area of the barbs.'" Neither of these assertions is supported by the Anderson specification – they are pure speculation and argument. In addition, both of these assertions take the Anderson disclosure wholly out of context. When read properly, one of ordinary skill in the art would understand removing material in the area of the barbs to mean removal of material so that the barbs themselves can bend outwardly. The mere fact that of the specification discloses a stent with arches that bend does not demonstrate that the barbs do not bend, nor does it alter the clear disclosure in the specification that the barbs do, in fact, bend.

D. The Examiner's Answer Still Does Not Provide Any Rational Underpinning For Combining Boatman With Anderson

As set forth above, the Examiner concedes that Anderson does not explicitly disclose an unbent barb and continues to rely on his already rejected inherency arguments that Anderson suggests this limitation. The Board has already rejected this argument. As set forth, in Appellants' primary brief, Anderson also does not disclose a barb that points in predetermined direction or one that is free of weakening due to bending. The Examiner's reliance on Boatman to make up for any alleged deficiencies of Anderson, **which the Examiner argues are none**, still has no rational underpinning.

First, the Examiner states that he turned to Boatman "in order to establish that fatigue life of stent portions (due to bending) is a well known issue. . . ." (Examiner's Answer, p. 9). But then, the Examiner's states "Boatman provides motivation to ensure the stent is engineered to provide an unbent barb with enhanced fatigue life since it has not been bent," (Examiner Answer, p. 9). This defies common logic. If Anderson discloses every element, including an unbent barb, as the Examiner continues to argue, either explicitly or inherently, **there is no logical reason to turn**

to a secondary reference. The Examiner simply has not and cannot provide any rational underpinning for combining these two references. In any event, the Examiner has failed to explain why a person of ordinary skill in the art (not the Examiner trying to piece together an obviousness rejection based on hindsight) would have been motivated to make the proposed combination. For these reasons also, the Board should reverse the Examiner's rejection.

II. CONCLUSION

Neither Anderson nor Boatman, alone or in combination, discloses, teaches, or suggests a stent with each and every feature recited in the present claims. Moreover, the Examiner has failed to establish that one of ordinary skill would have been motivated to combine Boatman, or that the combination would result in the claimed invention. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and the present rejection is improper. Appellants respectfully request that the Board reverse the present rejection.

Respectfully submitted,

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